

REMARKS

Applicant respectfully acknowledges receipt of the Office Action mailed October 18, 2005.

In the Office Action, the Examiner: (1) withdrew the indicated allowability of claims 13, 17, and 19; (2) rejected claims 1-6, 8, 9, 12-14, and 17-19 under 35 U.S.C. § 102(b) as being anticipated by *Kurz* (U.S. Patent No. 5,146,931); (3) rejected claim 11 under 35 U.S.C. §103(a) as being unpatentable over *Kurz*; and (4) objected to claim 7 as being dependent upon a rejected base claim, but would allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Before entry of this Reply, claims 1-9, 11-14, and 17-19 were pending in this application. After entry of this Reply, claims 1-9, 11-14, and 17-19 remain pending in this application. Claims 10, 15, and 16 were previously canceled in the "Amendment After Final" filed February 16, 2005.

Applicant gratefully acknowledges the Examiner's indication of allowable subject matter in claim 7. However, Applicant has not rewritten claim 7 to include all of the limitations of the base claim and any intervening claims because at least independent claim 1, without any substantive amendments, is patentably distinguishable over the cited prior art.

Applicant traverses each of the above rejections and respectfully requests reconsideration for at least the reasons that follow.

I. 35 U.S.C. § 102(b) REJECTION

Applicant submits that independent claim 1 is patentably distinguishable under 35 U.S.C. § 102 over the cited references, including *Kurz*, and the other art of record. The cited prior art fails to disclose or suggest each element of the invention recited in independent claim 1. In particular, the applied references, taken alone or in combination, at least fail to teach or suggest an internal substance delivery device for insertion into a body cavity, said device includes a support frame having at least two resilient arms which retain said device in the body cavity, wherein each resilient arm is capable of receiving and releasing a separate substance delivery means capable of releasing substance into the body cavity, and wherein the arms are biased outward from a central section of the support frame.

Applicant notes that in order to properly anticipate Applicant's claimed invention under 35 U.S.C. § 102, each and every element of the claim in issue must be found, "either expressly or inherently described, in a single prior art reference." "The identical invention must be shown in as complete detail as is contained in the . . . claim. *Richardson v. Suzuki Motor Co.*, 868 F.2d 1226, 1236, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989)." See M.P.E.P. § 2131, 8th ed., 2001.

Kurz discloses a device placed in the uterus, wherein the device includes a copper wire 10 wound around stem 1 for introducing copper ions into the uterus during a lengthy period. (*Kurz*, col. 4, ll. 16-20). Wires, which are impregnated with the desired agent, can also be fitted to the bent parts or extensions 5 of the device (emphasis added). (*Id.* at col. 4, ll. 21-29). *Kurz*, however, is silent as to having separate hormone releasing components (i.e. pods) that can be added as necessary to

the arms of the device as independent units, wherein the pods are attachable and releasable during treatment (emphases added). The “present invention obviates the need to impregnate the support frame with the substance to be delivered...[P]referred embodiments include drug delivery pods [that] are attachable and removable from the support frame. Thus, manufacture of the support frame is quite independent of the drug delivery system” (emphases added). (*Specification*, p. 6, ll. 11-15). Because the drug delivery pods are attachable and removable, “the present invention can provide two or more co-current treatments, two or more sequential treatments, or prolong a single treatment” (emphasis added). (*Id.* at p. 8, ll. 2-4).

Accordingly, *Kurz* necessarily fails to teach or suggest the claimed combination including, *inter alia*, “an internal substance delivery device...[including] a support frame having at least two resilient arms...wherein each resilient arm is capable of receiving and releasing a separate substance delivery means capable of releasing substance into the body cavity,” as recited in independent claim 1 (emphasis added). For at least these reasons, Applicant requests that the rejection of independent claim 1 under 35 U.S.C. § 102(b) be withdrawn and claim 1 be allowed.

Moreover, claims 2-9, 11-14, and 17-19 are allowable at least due to their dependence from independent claim 1. In addition, at least some of the dependent claims may recite unique combinations that are neither disclosed nor suggested by the cited art, and therefore some also are separately patentable.

II. 35 U.S.C. § 103(a) REJECTION

Applicant respectfully submits that claim 11 is patentably distinguishable over *Kurz*, and the other art of record, at least for the reasons described below.

As noted above, *Kurz* necessarily fails to teach or suggest the claimed combination including, *inter alia*, “an internal substance delivery device...[including] a support frame having at least two resilient arms...wherein each resilient arm is capable of receiving and releasing a separate substance delivery means capable of releasing substance into the body cavity,” as recited in independent claim 1 (emphasis added). Consequently, claim 11 is in condition for allowance at least due to its dependence from independent claim 1. Thus, the claim rejection set forth under 35 U.S.C. §103(a) is now moot and should be withdrawn.

III. CONCLUSION

Applicant respectfully submits that independent claim 1 is in condition for allowance. In addition, claims 2-9, 11-14, and 17-19 are in condition for allowance at least due to their dependence from independent claim 1.

The Office Action contains characterizations of the claims and the related art with which Applicant does not necessarily agree. Unless expressly noted otherwise, Applicant declines to subscribe to any statement or characterization in the Office Action.

In view of the foregoing amendments and remarks, Applicant respectfully requests reconsideration and reexamination of this application and the timely allowance of the pending claims.

Please grant any extensions of time required to enter this response and charge
any additional required fees to our deposit account 06-0916.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: January 18, 2006

By: David W. Hill
David W. Hill
Reg. No. 28,220